

- U.S. Patent Application No. 10/529,425
 - Attorney Docket No. 10191/4133
- Reply to Office Action of November 15, 2007

REMARKS

Claim 11 is canceled without prejudice, and therefore claims 10 and 12 to 18 are now pending in the present application.

Applicants thank the Examiner for acknowledging the claim for foreign priority and indicating that all certified copies of the priority documents have been received.

Applicants respectfully request that the Examiner acknowledge in the next Communication whether the Drawings are accepted.

It is respectfully requested that the present application be reconsidered since all of the presently pending claims are allowable.

Applicants thank the Examiner for indicating the claims 11, 15 and 16 contain allowable subject matter. While the objections and underlying rejections may not be agreed with, to facilitate matters, claim 10 has been rewritten to include the features of claim 11, which has been canceled without prejudice, and claim 15 has been rewritten to include the features of original claim 10. Accordingly, claims 10 and its dependent claims are allowable, as is claim 15 and its dependent claim 16. Claim 18 has also been rewritten to include a feature like that of claim 10, as presented, and is therefore allowable for essentially the same reasons. It is therefore respectfully requested that the objections be withdrawn.

Claims 10, 12, 17 and 18 were rejected under 35 U.S.C. § 102(b) as anticipated by Sakata et al., JP 06-324074. Claims 10, 12, 13, 17 and 18 were rejected under 35 U.S.C. § 102(b) as anticipated by Benz et al., U.S. Patent No. 5,542,558.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Actions to date do not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the

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determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

As explained above, while the rejections may not be agreed with, to facilitate matters, claim 10 has been rewritten to include the features of claim 11, which has been canceled without prejudice, and claim 15 has been rewritten to include the features of original claim 10. Accordingly, claims 10 and its dependent claims are allowable, as is claim 15 and its dependent claim 16. Claim 18 has also been rewritten to include a feature like that of claim 10, as presented, and is therefore allowable for essentially the same reasons. It is therefore respectfully requested that the rejections be withdrawn.

As to paragraph eight (8) of the Office Action, claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over the Sakata or Benz references.

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 14 depends from claim 10, as presented, and is therefore allowable for essentially the same reasons as claim 10, as presented, which now includes the features of canceled claim 11.

Accordingly, claims 10 and 12 to 18 are allowable.

CONCLUSION

In view of the foregoing, all of pending claims 10 and 12 to 18 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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